



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/509,891

10/01/2004

Frank Dietsche

4372-4

2859

23117 7590 04/08/2008
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

CAMERON, ERMA C

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

04/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/509,891	Applicant(s) DIETSCHKE ET AL.	
	Examiner /Erma Cameron/	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 33-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1, last three lines under ab1): the repetition makes the meaning unclear.

b) Claim 36: it is not clear what is meant by “nitrogen base”.

c) Claim 38 and 45: it is not clear if the layer is actually obtained, or is merely “obtainable”.

The above rejections were not addressed in the 1/30/2008 amendment.

d) Claim 1, last line of a): there is no antecedent basis for “ab”.

e) Claim 55: should be “tertiary alkaline amine”.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The rejection of Claims 33-51 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, is withdrawn because of the arguments presented 1/20/2008.

5. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This section of the last three lines of claim 33 (“...zinc cations...zinc alloys.”) is new matter that was not in the specification as originally filed. The applicant has argued that a person of skill in the art would know that the composition would comprise zinc cations because the composition would dissolve a certain amount of a zinc surface when applied to the zinc surface. The examiner disagrees that the above phrase may be added to claim 33 on this basis. The arguments of the applicant cannot take the place of evidence in the record. See MPEP 2145 I.

The applicant is requested to cancel new matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The rejection of Claims 33-51 under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al (US 2002/0146515) is withdrawn because of the amendment filed 1/30/2008.

8. Claims 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denzinger et al (5175361).

'361 teaches a composition that can be used as a scale inhibitor in a water system (1:61) that comprises water, 40-90 wt% of acrylic acid, 10-60 wt% of maleic anhydride and 0-20 wt% of VPA, as well as amine or ammonium salts, and other additives such as free radical initiators (2:3-2:55, see example 1).

The composition overlaps that claimed by applicant.

Response to Arguments

The applicant has argued that '361 does not teach treating metal surfaces. However, it is the examiner's position that "for treating metal surfaces" of claim 1 is merely intended use and is not a limitation. See MPEP 2111.02 II.

The applicant has further argued that the composition of '361 does not comprise one of the acids or salt of said acids as component F. The examiner disagrees. '361 clearly states that vinylsulfonic acid may be part of the composition (2:33-46).

9. Claims 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk et al (5601723).

'723 teaches a composition to be used in water circulating systems that comprises water, 3-50 wt % of maleic anhydride (5:43), 50-97 wt% of acrylic acid (5:61), 0-40 wt % of VPA (6:14), as well as amino containing compounds (6:3-22) and other additives such as water soluble metal salts or corrosion inhibitors (6:23-40) (2:34-62; 8:50-55; 10:58-11:5).

The composition overlaps that claimed by applicant.

Response to Arguments

The applicant has argued that '723 does not teach treating metal surfaces. However, it is the examiner's position that "for treating metal surfaces" of claim 1 is merely intended use and is not a limitation. See MPEP 2111.02 II.

In addition, the water circulating systems of '723 such as water towers or boilers (10:58-11:5) would encompass metals, and thus '723 does teach treating a metal surface.

The applicant has further argued that the composition of '361 does not comprise one of the acids or salt of said acids as component F. The examiner disagrees. '361 clearly states that allylsulfonic acid may be part of the composition (6:3-22).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

Art Unit: 1792

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1792

April 1, 2008